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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,212	07/28/2003	Suying Liu	2550-06	5308

7590 04/29/2005

Mr. C. P. Chang  
Pacific Law Group LLP  
Suite 525  
224 Airport Parkway  
San Jose, CA 95110

EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,212

Applicant(s)

LIU ET AL

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.  
4a) Of the above claim(s) 3 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2 and 4-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Applicant's election without traverse of claims 2-10 in the reply filed on February 1, 2005 is acknowledged. The applicant is requested to note that claim 3 should have been included with the non-elected group as it depends from non-elected claim 1 and relates to the method for manufacturing the paintball. Accordingly, claim 3 is withdrawn from further consideration and only claims 2 and 4-10 have been examined. It is noted that claim 3 should probably be canceled since it depends from canceled claim 1.

***Claim Objections***

2. Claim 8 is objected to because of the following informalities: The language "preferentially" is indefinite in positively defining the structure of the invention. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haman et al. (4,656,092). Regarding claims 2 and 4, Haman discloses a seamless paintball construction comprising a gelatin capsule and a nontoxic dye fill material. The fill material includes a vegetable oil such as soybean oil. Note column 2, lines 1-3 stating that that the fill material is nontoxic in case of accidental ingestion. Haman also states that the paintball may be sized for a variety of small caliber air guns (column 3, lines 5-19). The caliber listed by Haman is the size

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of a BB. However, Haman lacks the teaching for forming the gelatin capsule from 10%-34% (W/W) gelatin. It would have been obvious to one of ordinary skill in the art to form the gelatin capsule of Haman with 10%-34% (W/W) of gelatin as the applicant has not shown the criticality for this particular range by a new and unexpected result obtained therefrom and it appears that the gelatin capsule of Haman would accomplish similar purposes. It is noted that the claim recites PEG, starch and edible dye in distilled water, however, the claim uses the language "can also comprise". Thus, the claim is rendered obvious by the paintball of Haman as the claim permits the possibility for an embodiment that only contains the edible oil-based solution and a gelatin-based solution without the additionally listed materials. This embodiment is clearly taught by Haman.

Regarding claim 5, it would have been obvious to one of ordinary skill in the art to replace the oil of Haman with a short-chain or medium-chain fatty acid in order to provide an alternative edible oil that is suitable for use as the fill material.

Regarding claims 6-9, the recited polyethylene glycol is not required as part of the recipe for the gelatin-based aqueous solution since claim 2 uses the language "can also contain". Therefore, any limitations related to the PEG are not seen as being positively and necessarily defined in the claims.

Regarding claim 10, this claim uses the language "can consist". Therefore, the limitations for the PEG, starch and edible dye recited thereafter are not seen as being positively and necessarily defined in the claims and an embodiment that does not contain any of the additional materials would fulfill the limitations of the claim. Haman teaches this embodiment.

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The recited range for the gelatin is still considered to be obvious lacking a showing of the criticality for the claimed range by a new and unexpected result obtained therefrom.

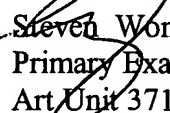
***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stolz teaches a paintball construction including the use of PEG having different molecular weights. Gilleland et al. teach a capsule construction including a starch material that may be used in forming the capsule. Brox et al. teach a capsule that uses PEG in its recipe.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
April 26, 2005